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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/625,102

Confirmation No. 8891

Applicant : Pedro M. Buarque de Macedo

Filed : July 22, 2003

TC/A.U. : 3635

Examiner : Gay Spahn

Docket No. : 50699/11

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REPLY TO RESTRICTION REQUIREMENT AND AMENDMENT

Mail Stop AMENDMENT  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the Office Action of March 9, 2005, please enter Applicant's Reply to Restriction Requirement and amend the above-identified patent application as follows:

**Reply to Restriction Requirement** begins on page 2 of this paper.

**Amendments to the Claims** are reflected in the listing of claims which begins on page 5 of this paper.

**Remarks** begin on page 10 of this paper.

**Reply to Restriction Requirement:**

The March 9, 2005 Office Action in the above-referenced U.S. patent application required Applicant to elect from the following two groups of the patentably distinct species of the claimed invention:

1) Group I (which are patentably distinct species of the claimed prestressed foam glass tile and assembly): Figure 1; Figure 2; Figures 3A and 3B; Figures 4A and 4B; Figures 5A and 5B; and Figure 6; and

2) Group II (which are patentably distinct species of the claimed tension member(s)): bolt(s), wire(s), carbon fiber(s), standard/compact seven-wire prestressing strand(s), rod(s)/bar(s), angle iron(s), and plate(s)).

The March 9, 2005 Office Action required Applicant "to elect a single disclosed species from each of the two groups of the claimed invention for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable." (Mar. 9, 2005 Office Action, at 2). Applicant respectfully traverses the restriction requirement set forth in the March 9, 2005 Office Action for the following reasons:

Applicant respectfully disagrees that Figure 1, Figure 2, Figures 3A and 3B, Figures 4A and 4B, Figures 5A and 5B, and Figure 6 in Group I respectively embody patentably distinct species of the claimed prestressed foam glass tile and assembly. Likewise, Applicant respectfully disagrees that bolt(s), wire(s), carbon fiber(s), standard/compact seven-wire prestressing strand(s), rod(s)/bar(s), angle iron(s), and plate(s) in Group II respectively embody patentably distinct species of the claimed

tension members. In the March 9, 2005 Office Action, the Examiner did not provide a *prima facie* showing of patentably distinct inventions by way of an appropriate explanation that the present invention as set forth in the pending claims directed to different species of Group I and Group II would require a separate classification, a separate status in the art, or a different field of search. MPEP 803 and 808.02.

In addition, it is respectfully submitted that even if divided among different applications, the claims directed to different species of Group I and Group II will most likely be assigned to the same group art unit in the U.S. Patent Office and will require the same prior art search. Accordingly, Applicant respectfully submits that keeping the claims directed to all of the species listed in Group I and Group II together in one application would not impose a serious burden on the Examiner. Rather, keeping all the pending claims together will simplify the examination work of the U.S. Patent Office by eliminating the need for duplicative search by the same Examiner.

To impose a proper restriction requirement, the inventions must be independent or distinct as claimed, and there must be a serious burden on the Examiner if the requirement is not imposed. MPEP 803. It is respectfully submitted that neither of these criteria for imposing a proper restriction requirement has been shown by the Examiner as discussed above. In view of the foregoing, Applicant respectfully requests that the restriction requirement be withdrawn and that all the pending claims be allowed to be prosecuted together in the present application.

In the event that the restriction requirement is made final by the Examiner, and in order to comply with 37 C.F.R. § 1.143, Applicant provisionally elects, with traverse,

Claims 1-5, 13, 14, 23-27, 29-31, 37 and 41 drawn to Figure 1 from Group I and the tension bolts from Group II, holding the non-elected claims in abeyance under the provisions of 37 C.F.R. § 1.142(b) until final disposition of the elected claims.

In the March 9, 2005 Office Action, the Examiner stated:

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species from each of the two groups of the claimed invention for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, independent claim 1 appears to be generic.

(Mar. 9, 2005 Office Action, at 2) (emphasis added). It is respectfully submitted that the remaining independent claims, Claims 23 and 41, are also generic claims.

Accordingly, Applicant respectfully requests that the Examiner confirm that the Examiner will withdraw the restriction requirement set forth in the March 9, 2005 Office Action once the generic claim, Claim 1, 23, or 41, is allowed.